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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,823	03/26/2004	Blayn W. Beenau	60655.8400	2822
20322	7590	11/28/2005	EXAMINER	
SNELL & WILMER ONE ARIZONA CENTER 400 EAST VAN BUREN PHOENIX, AZ 850040001			NGUYEN, NAM V	
			ART UNIT	PAPER NUMBER
			2635	

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/708,823	Applicant(s) BEENAU ET AL. JS	
	Examiner Nam V. Nguyen	Art Unit 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/4/9;3/26/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The application of Beenau et al. for a "method for biometric security using a transponder-reader" filed March 26, 2004 has been examined.

This application is a CIP of 10/340,352 filed January 10, 2003, which is a CIP of 10/192,488 filed July 9, 2002, which claims the benefit of 60/304,216 filed July 10, 2001 and said 10/340,352 filed January 10, 2003, which is a CIP of 10/318,432 filed December 13, 2002 and is a CIP of 10/318,480 filed December 13, 2002, and is a CIP of 60/396,577 filed July 16, 2002.

Claims 1-9 are pending.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

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The current abstract using phrase “the present invention” and “the invention” is implied and should be avoided. See MPEP 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “proffering a biometric to a biometric sensor communicating with said system to initiate verification of a biometric sample for facilitating authorization of a transaction” is confusing and unclear. It is not understood what is meant by such a limitation. What is the step of proffering a biometric means? Is a sensor detecting a proffered biometric sample? Is the sensor located in the transponder, in a reader or in a system? What is the difference between proffering a biometric and a biometric sample? Where is this limitation supported by specification? Claims 2-9 are rejected for their dependence on Claim 1 and include the same limitations of Claim 1 without correcting the ambiguity.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kita (US# 6,703,918).

Referring to claim 1, Kita discloses an authentication method as recited in claim 1. See Figures 1-30 and respective portions of the apparatus and method.

Kita discloses a method for facilitating biometric security in a transponder-reader transaction system (i.e. a portable information system) comprising: proffering a biometric (i.e. fingerprint) to a biometric sensor (8) communicating with said system to initiate verification of a biometric sample (i.e. authentication data) for facilitating authorization of a transaction (column 4 line 20 to column 5 line 9; column 6 line 44 to column 7 line 28; column 10 line 62 to column 11 line 14; see Figures 1-3, 6-7 and 10-11).

Referring to claim 2, Kita discloses method of claim 1, further comprising registering at least one biometric sample (i.e. authentication data) with an authorized sample receiver (8) (column 9 line 66 to column 10 line 59; column 11 line 15 to 61; see Figures 10-11).

Referring to claim 3, Kita discloses method of claim 1, wherein said step of registering further includes at least one of: contacting said authorized sample receiver (32) (i.e. a wireless transmission reception section), proffering a biometric (i.e. fingerprint) to said authorized sample receiver (32), processing said biometric to obtain a biometric sample (i.e. authentication data), associating said biometric sample (i.e. authentication data) with user information, verifying said biometric sample (i.e. authentication data), and storing said biometric sample upon verification (column 9 lines 66 to column 10 line 59; column 11 line 15 to 61; see Figures 10-11).

Referring to claim 4, Kita discloses method of claim 1, wherein said step of proffering further includes proffering a biometric (i.e. fingerprint) to a biometric sensor (8) communicating with said system to initiate at least one of: storing, comparing, and verifying said biometric sample (i.e. authentication data) (column 9 lines 66 to column 10 line 59; column 11 line 15 to 61; see Figures 10-11).

Referring to claim 5, Kita discloses method of claim 1, wherein said step of proffering a biometric (i.e. fingerprint) to a biometric sensor (8) communicating with said system to initiate verification further includes processing database information (i.e. authorized data in an organic authentication registration data), wherein said database information (registration data) is contained in at least one of a transponder (151) (i.e. a equipment) (column 10 line 63 to column 11 line 61; see Figures 10-11).

Referring to claim 6, Kita discloses method of claim 1, wherein said step of proffering a biometric (i.e. fingerprint) to a biometric sensor (8) communicating with said system to initiate verification further includes comparing a proffered biometric sample (i.e. authentication data) with a stored biometric sample (i.e. organic authentication registration data registered in the organic authentication registration data unit 154) (column 11 line 42 to 61; see Figures 10-11).

Referring to claim 7, Kita discloses method of claim 6, wherein said step of comparing includes comparing a proffered biometric sample (i.e. authentication data) to a stored biometric sample (i.e. registration data) by using at least one of a third-party security vendor device (37) (i.e. service business) and protocol/sequence controller ((152) (i.e. a control circuit) (column 5 line 40 to column 7 line 52; column 10 line 62 to column 11 line 67; see Figure 1-7 and 10-11).

Referring to claim 8, Kita discloses method of claim 6, wherein said step of proffering a biometric to a biometric sensor communicating with said system to initiate verification further

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includes at least one of detecting, processing and storing at least one second proffered biometric sample (i.e. authentication data) (column 9 line 66 to column 10 line 36).

Referring to claim 9, Kita discloses method of claim 1, wherein said step of proffering a biometric to a biometric sensor communicating with said system to initiate verification further includes the use of at least one secondary security procedure (column 10 line 50 to 60; column 11 line 42 to column 12 line 4; see Figures 9-11).

Double Patenting

Claim 1 is provisionally rejected on the ground of nonstatutory double patenting over claim 1 of copending Application No. 10/708,824. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: proffering a biometric (i.e. fingerprint) to a biometric sensor (8) communicating with said system to initiate verification of a biometric sample (i.e. authentication data) for facilitating authorization of a transaction.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claim corresponding to those of the instant application in the other copending

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application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kinsella (US# 6,914,517) disclose a fingerprint sensor with feature authentication.

Hamid et al. (US# 6,877,097) disclose a security access method and apparatus.

Glass et al. (US# 6,332,193) disclose a method and apparatus for security transmitting and authenticating biometric data over a network.

Black (US# 6,307,956) discloses a writing implement for identity verification system.

Pare, Jr. et al. (US# 6,154,879) disclose a tokenless biometric ATM access system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nam V Nguyen whose telephone number is 571-272-3061. The examiner can normally be reached on Mon-Fri, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on 571-272-3068. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nam Nguyen
November 19, 2005



MICHAEL HORABIK
SUPERVISORY PATENT EXAMINER
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